



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0633-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
David W. CANNELL et al.)	Group Art Unit: 1617
)	
Application No.: 09/648,376)	Examiner: S. Wang
)	
Filed: August 25, 2000)	
)	
For: PROTECTION OF KERATINOUS)	Confirmation No.: 5418
FIBERS USING CERAMIDES)	
AND/OR GLYCOCERAMIDES)	

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to the Examiner's Answer dated January 29, 2007. A Request for Oral Hearing is concurrently filed with this Reply Brief.

If any fees are required in connection with the filing of this paper that are not filed herewith, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

I. ARGUMENT

A. The Cited References Do Not Teach or Suggest all of the Claim Limitations

In his Answer, the Examiner contends that Appellants, in showing that the cited references do not teach or suggest all of the claim limitations, are arguing against the references separately. Ex. Answer at 5. The Examiner also misapplies case law by stating “one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” *Id.* at 5-6 (citing *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)).

Appellants note that they are not arguing against each reference separately. Rather, Appellants are merely pointing out how the combination of the cited references fail to teach or suggest all of the claim limitations, which necessarily requires a reference by reference examination.

Moreover, in *In re Keller* and *In re Merck* the applicants attempted to rebut a prima facie case of obviousness with a Declaration attacking or countering only one of the cited references. See, e.g., *In re Keller*, 642 F.2d at 425-426, 208 USPQ at 882. Appellants note that they are not rebutting a prima facie case of obviousness. Rather, Appellants are showing that the Examiner has not established a prima facie case of obviousness, at least because the cited references do not teach or suggest all of the claimed elements as required. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, in both cases, the arguments against a single cited reference were intended to show lack of motivation, and not missing elements as in the present case.

Therefore, the Examiner's assertion that the Appellants are improperly arguing against the references separately is misplaced.

1. Claims 1-3, 5-12, 16-26, and 53

The Examiner has admitted that *Dubief* and *Grollier* do not teach polyquaternium-22. The Examiner continues to assert, however, that *Cauwet* teaches the claimed weight ratio, i.e., the weight ratio of said at least one cationic polymer to polyquaternium-22 is greater than or equal to 3:1, or greater than or equal to 2:1. See, e.g., Claims 1 and 53. The Examiner's assertion is flawed.

The only relevant teaching in *Cauwet* is the discussion of a "synergistically effective" weight ratio. The Examiner wishes to ignore the teaching of *Cauwet* as whole, including the abstract and specification of *Cauwet*, which expressly teach that the weight content of cationic polymers needs to be equal to or less than amphoteric polymers. As previously argued by Appellants, the Examiner cannot pick and choose from a reference only the teachings that suit his purpose. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must also be considered. See *Bausch & Lomb, Inc. v. Barnes Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986).

Moreover, the Examiner wishes to give more weight to the phrase "synergistically effective" weight ratio taught by the claims of *Cauwet*, than to the express teachings of *Cauwet* that breathe life into its claims. The Examiner argues that "Applicants may not read too much of the specification into the claims." Ex. Answer at 8. In contrast, it is the Examiner's focus solely on the claims that is misguided. While a patentee is free to be his own lexicographer, any special definition given to a word must be clearly defined

in the specification. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-80 (Fed. Cir. 1995) (*in banc*), *aff'd*, 517 U.S. 370, 116 S. Ct. 1384 (1996). Thus, Appellants can look to Cauwet's specification for clarification on claim terms.

The specification of *Cauwet* states that "[i]t has been discovered that the combination of certain conditioning polymers . . . when they are used in a given ratio make it possible to overcome these disadvantages due to a synergistic effect that is achieved." *Cauwet* specification at col. 1, lines 49-53 (emphasis added). The specification of *Cauwet* further teaches the synergistic combination is a ratio of cationic to amphoteric polymer of no greater than 1. See *Cauwet* specification at col. 2, lines 1-33. Thus, the Examiner cannot ignore that *Cauwet* expressly teaches a weight ratio of cationic polymers to amphoteric polymers in the opposite direction as the currently claimed ratio. As previously argued by Appellants, such a teaching by *Cauwet* is, in fact, a teaching away from the presently claimed invention. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994) (emphasis added).

The Examiner attempts to rebut the facts by arguing that "[i]t is well settled that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or no preferred embodiments." Ex. Answer at 7 (citing *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971)). Appellants submit that the Examiner is, once again, citing case law that is not applicable to the present facts. In *In re Susi*, the applicant argued that the subclass of a "more particularly preferred embodiment" taught

away from the subclass of a “particularly preferred embodiment.” Wherein the court noted, in a footnote, that “one is not significantly ‘taught away’ from a ‘particularly preferred embodiment’ by the suggestion . . . that something else may be even better.” *In re Susi*, 440 F.2d at 446, n. 3. Appellants are not trying to differentiate between two preferred embodiments of *Cauwet*. Rather, Appellants are correctly pointing out that all of the embodiments of *Cauwet* teach away from the presently claimed ratio.

Finally, despite the fact that *Grollier* does not teach the use of polyquaternium-22, the Examiner argues that *Grollier* discloses “a broad ratio range of cationic polymer/amphoteric polymer,” and that the claimed ratio “would have been obvious over the range disclosed in the prior art (1:10 to 10:1[]).” Ex. Answer at 8. While not expressly stated by the Examiner, such a statement can only be interpreted as an attempt to argue that there would be a “routine optimization” of the range disclosed in *Grollier* to arrive at the claimed weight ratio. See M.P.E.P. § 2144.08(II).

Appellants submit that the Examiner’s conclusion is legally and factually wrong. Before the determination of the optimum or workable ranges of a variable can be characterized as “routine experimentation,” the variable must first be recognized as a result-effective variable, as suggested by the reference cited. See *In re Antonie*, 559, F.2d 618, 195 USPQ 6 (CCPA 1977). As previously argued, there is no part of *Grollier* that could be construed as teaching that the ratio of cationic to amphoteric polymers is result-effective. This is further emphasized by the broad range of ratios taught by *Grollier*. Moreover, *Grollier*’s range is so broad that it is analogous to a genus that does not render the species obvious. See *In re Baird*, 16 F.3d 380, 383, 29 USPQ2d 1550,

1552 (Fed. Cir. 1994) (“A disclosure of millions of compounds does not render obvious a claim to three compounds”)

Thus, within the combination of the three cited references, there is no teaching of at least one amphoteric polymer chosen from polyquaternium-22 wherein the weight ratio of said at least one cationic polymer to said at least one amphoteric polymer is greater than or equal to 3:1, or greater than or equal to 2:1. See, e.g., Claims 1 and 53. Accordingly, for at least the foregoing reasons, the Examiner has not established a prima facie case of obviousness.

In his Answer, the Examiner inexplicably states “[a] known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” Ex. Answer at 6-7 (citing *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994)). Thus, the Examiner concludes that “absent evidence showing an unexpected benefit residing in the particular ratio herein, the claims have been properly rejected.” *Id.* at 7.

Appellants are confused by, and disagree with, the Examiner’s argument both on a factual and legal basis. First, Appellants maintain that the claimed invention is not known or obvious. Second, Appellants have not ever stated or implied that *Cauwet*’s “teaching away” from the claimed weight ratio indicates that the claimed invention is inferior to *Cauwet*. Finally, there is no burden on Appellants to submit test results regarding the claimed ratio as the Examiner has not established a prima facie case of obviousness.

2. Claim 50

The Examiner has not even attempted to rebut Appellants argument that the three cited references combined do not teach or disclose a kit, let alone a multi-compartment kit as-claimed.

The Examiner continues to assert that “making a kit comprising the composition herein and other hair treating composition, such as hair dyeing composition is obvious to one of ordinary skill in the art because such composition is known to be particularly useful before or after other hair treatment.” Ex. Answer at 8. Such a conclusion does not point to any specific teaching in the cited references because no such teaching exists.

Indeed, as previously argued, the only reference that arguably teaches a multi-compartment kit is *Grollier*, which teaches “two stage formulations.” See *Grollier* at Examples 21-23. However, the two stage formulations of *Grollier* actually separate the specific cationic and specific amphoteric polymers, contrary to the kit compositions as claimed. *Id.* Moreover, neither Dubief nor Cauwet teach or suggest a two-step composition or process that would indicate a multi-compartment kit as-claimed.

If a kit as-claimed is as obvious as the Examiner asserts, it should not have been difficult for him to have produced a reference disclosing it. It is clear that the Examiner has not considered all words of claim 53 as required by M.P.E.P. § 2143.03. Accordingly, for at least the foregoing reasons, the Examiner has not established a prima facie case of obviousness.

B. There is No Motivation to Combine *Dubief* with *Cauwet* and *Grollier*

1. Claims 1-3, 5-12, 16-26, and 53

Even assuming, *arguendo*, that the cited references teach or suggest the claim limitations, the Examiner has not shown any suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the cited references to arrive at the present claims. As previously argued, in order to support a rejection under 35 U.S.C. § 103, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d at 1357, 47 U.S.P.Q.2d at 1458 (Fed. Cir. 1998) (emphasis added).

The Examiner merely repeats his contention that both *Grollier* and *Cauwet* "teach the benefit of the combination of cationic polymer and amphoteric polymers, and both [sic] teach a broad range of the ratio of the polymers." Ex. Answer at 6. The Examiner also asserts that the "question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered." *Id.* at 6 (citing *In re Lamberti and Konort* (CCPA), 192 USPQ 278). The Examiner also continues to misapply *In re Susi* by stating "[i]t is well settled that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure. . . ." *Id.* (citing *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971)).

However, as discussed above, all of the preferred embodiments of *Cauwet* teach away from the claimed ratio, and the Examiner now admits that the claimed ratio “does not fall within the preferred ratio of *Cauwet et al.*” Ex. Answer at 6. Further, as discussed above, the broad range of ratios disclosed in *Grollier* would not teach or suggest to one of ordinary skill in the art that the ratio of at least one cationic polymer to at least one amphoteric polymer is a result-effective parameter, and thus would not provide motivation, especially in combination with *Dubief* and *Cauwet*, to create a composition with the claimed ratio.

Thus, the Examiner has not shown that one of ordinary skill in the art would have been motivated to combine the teachings of *Dubief*, *Grollier* and *Cauwet* in order to create the presently claimed invention. The Examiner has failed to establish particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components of the claimed invention from the cited references for combination in the manner claimed. See *Kotzab*, 217 F.3d at 1371, 55 USPQ2d at 1318 (Fed. Cir. 1998). Accordingly, the Examiner cannot and has not satisfied the burden of proof to establish a prima facie case of obviousness with respect to claims 1-3, 5-12, 16-26, and 53.

2. Claim 50

As discussed above, the Examiner’s attempt to show a prima facie case of obviousness with respect to claim 50 rests solely on his conclusion that “making a kit comprising the composition herein and other hair treating composition, such as hair dyeing composition is obvious to one of ordinary skill in the art because such composition is known to be particularly useful before or after other hair treatment.” Ex.

Answer at 8. The Examiner has not even bothered to rebut Appellants' argument that such a statement does not show any particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components of the claimed invention from the cited references for combination in the manner claimed, as the Examiner is required to show. See *Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 1998).

Broad statements, such as the one made by the Examiner, are not enough to satisfy the Examiner's burden to prove obviousness. Appellants respectfully submit that the Examiner has not and cannot point to the required "clear and particular" teaching as one does not exist. Accordingly, the Examiner cannot and has not satisfied the burden of proof to establish a prima facie case of obviousness with respect to claim 50.

II. CONCLUSION

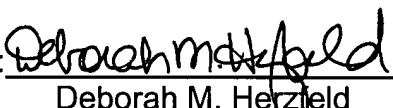
For the reasons given above, rejected claims 1-3, 5-12, 16-26, 50, and 53 are allowable and reversal of the Examiner's rejection is respectfully requested. The Examiner has failed to establish a prima facie case of obviousness at least because the cited references do not teach each claim limitation, and there is no motivation to combine the cited references.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: March 27, 2007

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